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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/091,651

03/05/2002

Brady R. Dow

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03/23/2010

HAMILTON, DESCANTIS & CHA (GENERAL)

8601 W. CROSS DRIVE

F5-301

LITTLETON, CO 80123

EXAMINER

BADII, BEHRANG

ART UNIT

PAPER NUMBER

3694

MAIL DATE

DELIVERY MODE

03/23/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/091,651
Filing Date: March 05, 2002
Appellant(s): DOW, BRADY R.

Douglas M. Hamilton
For Appellant

**Supplemental
EXAMINER'S ANSWER**

This is in response to the appeal brief filed 11/9/06 appealing from the Office
action mailed 9/25/06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct. The present application includes claims 2-4 and 6-25, all of which stand rejected.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

New grounds of rejection

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 12-23, 25 and 6-11 are rejected under 35 U.S.C. 101 because based on Supreme Court precedent (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v.*

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Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780, 787-88 (1876).) and recent Federal Circuit decisions, the Office's guidance is that a 101 process must (1) be tied to particular machine) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. (The Supreme Court recognizes that this test is not necessarily fixed or permanent and may evolve with technological advances. Gottschalk v. Benson, 409 U.S. 63, 71 (1972)). If neither of these requirements is met by the claim, the method is not a patent eligible process under 101.

The claims have to do with a method for controlling a network of conversation control system and are not tied to a particular machine or fail to transform the underlying subject matter. Information is routed from the human recipient to the conversation control system. This does not impose meaningful limits on the method to pass the test. Further, steps such as outputting data or receiving data (from a human operator) or presenting the script item to the human recipient are insignificant extra solution activity which do not transform an unpatentable principle into a patentable process. Therefore, the two corollaries to the machine-or-transformation test have not been met in the claim limitations.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Hirni et al., USP 6,731,609; Hayashi, USP 6,722,989; Atsmon et al., USP 6,607,136; Borman et al., USP 6,748,055.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 12, 24 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are replete with errors. Some examples follow.

- I. It is unclear as to who is initiating the contact.
- II. It is unclear as to who is the human recipient? Is this a customer? Is this recipient a call center employee?
- III. How is the recipient sending information if he/she is by definition a recipient?

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 12-23, 25 and 6-11 are rejected under 35 U.S.C. 101 because based on Supreme Court precedent (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972);

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Cochrane v. Deener, 94 U.S. 780, 787-88 (1876).) and recent Federal Circuit decisions, the Office's guidance is that a 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. (The Supreme Court recognizes that this test is not necessarily fixed or permanent and may evolve with technological advances. Gottschalk v. Benson, 409 U.S. 63, 71 (1972)). If neither of these requirements is met by the claim, the method is not a patent eligible process under 101.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 24, 2-4, 25, 6-8, 12-17 & 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirni et al., U.S. patent 6,731,609, and further in view of Hayashi, U.S. patent 6,722,989.

As per claim 24, Hirni et al. discloses a network of conversation control systems, the network comprising: at least a first and a second (col.2, 12-23) conversation control system; and a central control (call center), wherein the central control is communicably coupled to the first and the second conversation control systems (Abstract; Fig. 1), wherein the first and second conversation control system is accessible to a first and second human operator (user), wherein the first and second conversation control

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system is operable to receive input from the first and second human operator (user) (abstract; fig's 1, 4, 12-13).

Hirni et al. does not discloses script items formed in a presentation, selection of a script item and performing the script item. Hayashi discloses scripts items formed in a presentation, selection of a script item and performing the script item (abstract, fig's. 24, 26 & 19; col.16, 62-67; col.17, 1-11). It would have been obvious to modify Hirni et al. to include scripts items formed in a presentation such as that taught by Hayashi in order to allow the user to choose a response such that the conversation can be directed in a particular way, along a particular route to come to a certain conclusion and using the script programs which are used to generate the sentences.

As per claim 2, Hirni et al. further discloses an initiator, wherein the initiator (dialer, caller, calling system) is communicably coupled to the central control (Abstract; Fig. 1).

As per claim 4, Hirni et al. further discloses a central control comprising a set of components, and wherein the set of components is copied (routed) to both the first conversation control system and the second conversation control system under direction of the central control (Abstract; Fig. 1; col. 1, lines 42-58).

As per claim 25, Hirni et al. discloses a method for providing information to one or more recipients, the method comprising: providing a first conversation control system, wherein the first conversation control system includes a computer readable medium associated with the first conversation control system; providing a second conversation control system, wherein the second conversation control system includes

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a computer readable medium associated with the second conversation control system; providing an initiator; communicating with the initiator, wherein a human (user) recipient is contacted; and selecting one of the first conversation control system or the second conversation control system to interact with the human recipient; and communicating with the recipient via the selected conversation control system (Abstract; Fig. 1, 4, 12 & 13), receiving an indication from a human operator (user) associated with the selected conversation control system (col.25, 49-57; abstract; fig.1). Hirni et al. does not disclose a plurality of performed script items. Hayashi discloses a plurality of performed script items (abstract, fig's. 24, 26 & 19). It would have been obvious to modify Hirni et al. to include a plurality of performed script items such as that taught by Hayashi in order to allow the user to choose a response such that the conversation can be directed in a particular way, along a particular route to come to a certain conclusion and using the script programs which are used to generate the sentences.

As per claim 7, Hirni et al. further discloses maintaining components (packets) for use by the first and second conversation control systems on a central control (col. 1, lines 42-58); and updating both the first and second conversation control systems with the components (col. 30, lines 20-30).

As per claim 8, Hirni et al. further discloses determining if a component on the first conversation control system is less recent than a component on the central control (col. 30, lines 20-30).

As per claim 12, Hirni et al. further discloses a network of conversation control systems, the method comprising: initiating contact with a human (user) recipient via an

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initiator; selecting a conversation control system, wherein the conversation control system is accessible to a human operator (user); routing information received from the human recipient to the conversation control system; outputting the information received from the human in the form of an audio communication (col.4, 15-32; fig.2; col.1, 42-58) recipient via an output device of the conversation control system to the human operator (user); receiving an indication from the human (user) to respond to the information received from the human recipient; and presenting the script item to the human (user) recipient (Abstract; Fig's. 1, 2, 4, 12-13). Hirni et al. does not disclose a performed script item. Hayashi discloses a performed script item (abstract, fig's. 24, 26 & 19). It would have been obvious to modify Hirni et al. to include a performed script item such as that taught by Hayashi in order to allow the user to choose a response such that the conversation can be directed in a particular way, along a particular route to come to a certain conclusion and using the script programs which are used to generate the sentences.

As per claim 13, Hirni et al. further discloses receiving an indication of a script, wherein the script item is associated with a step of the script (packet technology) (col. 1, 42-58).

As per claim 14, Hirni et al. further discloses receiving an indication of a presentation, wherein the presentation controls the form that the script item is presented to the recipient (col. 1, lines 15-27, lines 65-67; col. 2, lines 1-11). Hirni et al does not disclose a combination (set) of script items. Hayashi discloses a combination (set) of scripts (abstract; col.16, 62-67; col.17, 1-11; fig's 24, 26 & 19). It would have been

obvious to modify Hirni et al. to include a combination (set) of scripts such as that taught by Hayashi in order to choose a response such that the conversation can be directed in a particular way, along a particular route to come to a certain conclusion and using the script programs which are used to generate the sentences.

As per claim 15, Hirni et al. further discloses the indicated presentation as a voice presentation (col. 5, lines 37-52).

As per claim 16, Hirni et al. further discloses the voice presentation as a particular person's voice (col. 19, lines 15-21).

As per claim 17, Hirni et al. further discloses the person's voice as pre-recorded (col. 11, lines 56-59).

As per claim 21, Hirni et al. further discloses the selecting of the conversation control system is done by determining which of a plurality of conversation control systems is currently not in use (col. 25, lines 63-67; col. 26, lines 1-13).

As per claim 22, Hirni et al. further discloses selecting the conversation control system is done by determining which of a plurality of conversation control systems is about to terminate use (col. 9, lines 7-22; col. 26, lines 40-60).

As per claim 23, Hirni et al. further discloses providing a central control, wherein selection of the conversation control system is effectuated by the central control via a computer network (fig. 1; col. 1, lines 65-67; col. 2, lines 1-12; col. 2, lines 24-40).

As per claims 3,6 and 20, Hirni et al. further discloses the initiator as a predictive dialer (caller, request to make calls) (col. 26, lines 7-13).

Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirni et al., U.S. patent 6,731,609 as applied to claim 5 above, and further in view of Atsmon et al., U.S. patent 6,607,136. As per claim 5, Hirni et al. discloses a method for providing information to one or more recipients as described above. As per claim 9, Hirni et al. does not disclose a computer associated with a database, wherein the database comprises one or more audio files; a speaker; and a input device. Atsmon et al. discloses a computer associated with a database, wherein the database comprises one or more audio files; a speaker; and a input device (Fig. 1, 29, 45 and 47; col. 35, lines 12-19; col. 51, lines 45-60). It would have been obvious to modify Hirni et al. to include a computer associated with a database, wherein the database comprises one or more audio files; a speaker; and a input device such as that taught by Atsmon et al. in order to have more ways to communicate via a computer and in order to have the database, including the audio files within the computer to make sending audio data more feasible and have more personal control over the sent data.

As per claim 10, Atsmon et al. further discloses receiving a first audio signal from the recipient; and outputting the first audio signal via the speaker to a user (Fig. 1, 29, 45 and 47; col. 35, lines 12-19; col. 51, lines 45-60).

As per claim 11, Atsmon et al. further discloses receiving a selection from the user at the input device of the first conversation control system, wherein the selection designates an audio file; and converting the audio file to a second audio signal; and

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outputting the second audio signal to the recipient (Fig. 1, 29, 45 and 47; col. 35, lines 12-19; col. 51, lines 45-60).

Claims 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirni et al., U.S. patent 6,731,609 as applied to claim 14 above, and further in view of Borman et al., U.S. patent 6,748,055. As per claim 14, Hirni et al. discloses receiving an indication of a presentation, wherein the presentation controls the form that the script item is presented to the recipient (col. 1, lines 15-27, lines 65-67; col. 2, lines 1-11). Hirni et al. also discloses the software being written in different languages including Java (col. 41, lines 40-55). As per claim 18, Hirni et al. does not disclose the indicated presentation being in the recipient's language. Borman et al. discloses the indicated presentation being in the recipient's language and that the Java language is used in this software program (col. 11, lines 30-50). It would have been obvious to modify Hirni et al. to include the indicated presentation being in the recipient's language such as that taught by Borman et al. in order to be able to have a platform that is language independent, therefore the system being capable of communicating in different languages according to where the user is from and what language the user speaks. Since the Java platform is used in the software being used, the system is language independent.

As per claim 19, Borman et al. further discloses the recipient's language not being the user's language (col. 11, lines 30-50).

(10) Response to Argument

Argument A:

As it is stated in the body of the rejection, claims 12, 24 and 25 are indefinite for failing to particularly point out and distinctly claim the subject the matter.

The claims stand rejected because it is unclear who is initiating the contact and who is the human recipient. It is unclear as to if this human recipient is a customer or if this recipient a call center employee. Further it is fatally unclear as to how this recipient is sending information if he/she is by definition a recipient. The applicant has made no effort to clear these ambiguities.

Arguments B, C, D and E:

This is a 103 rejection. The secondary reference (Hayashi) is used to show the selection from script items are well known in the art. Hayashi clearly shows this through out its patent. For example this is discussed in Hayashi at col.16, 62-67; col.17, 1-11, fig's 24, 26 and 19; abstract. Further, applicant is arguing that a machine does the selection from script items and not a human. According to the case law below:

III. AUTOMATING A MANUAL ACTIVITY

In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) (Appellant argued that claims to a permanent mold casting apparatus for molding trunk pistons were allowable over the prior art because the claimed invention combined "old permanent-mold structures together with a timer and solenoid which automatically actuates the known pressure valve system to release the inner core after a predetermined time has elapsed." The court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to

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distinguish over the prior art.).

Hence, if a machine can automate a certain procedure, it is obvious that a human at one point previous to being automated did this procedure manually.

Also, these two references are very much related as both are emphasizing conversation systems.

Although our predecessor court was the first to articulate the motivation suggestion-teaching test, a related test – the analogous art test – has long been part of the primary Graham analysis articulated by the Supreme Court. See *Dann*, 425 U.S. at 227-29; *Graham*, 383 U.S. at 35. The analogous art test requires that the Board show that a reference is either in the field of the applicant's endeavor or is reasonably pertinent to the problem with which the inventor was concerned in order to rely on that reference as a basis for rejection. In *re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992). References are selected as being reasonably pertinent to the problem based on the judgment of a person having ordinary skill in the art. *Id.* (“[I]t is necessary to consider the reality of the circumstances, ‘ – in other words, common sense – in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor. (Quoting *In re Wood*, 599 F.2d 1032, 1036 (CCPA 1979).

In many, if not most, situations, there is neither a motivation to make the modification clearly articulated in the references nor an evident lack of motivation. Rather, the prior art references typically disclose elements or aspect of the claimed subject matter, but fail to specifically point the way toward the combination, substitution or other

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modification needed to arrive at the inventions. A judgment must be made whether “a person of ordinary skill in the art would have had sufficient motivation to combine the individual [elements] forming the claimed [invention].” In re Clinton, 527 F.2d 1226, 1228, 188 USPQ 365, 367 (CCPA 1976).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Behrang Badii/

Primary Examiner, Art Unit 3694

Conferees:

/James P Trammell/

Supervisory Patent Examiner, Art Unit 3694

Vincent Millin /vm/

Appeals Practice Specialist

A Technology Center Director or designee must personally approve the new grounds(s) of rejection set forth in section (9) above by signing below

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/Wynn W. Coggins/

Director, TC 3600